



DOCKET NO. 073937.000008

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Harrison G. Purvis, et al.,
Appellants,

BRIEF OF APPELLANTS

RECEIVED
JUL 31 2002
GROUP 3600

Jeffrey S. Whittle
Registration No. 36,382
Bracewell & Patterson, L.L.P.
711 Louisiana St., Suite 2900
Houston, Texas 77002-2781
Telephone: (713) 221-1185
Facsimile: (713) 221-2141

ATTORNEY FOR APPELLANTS

TABLE OF CONTENTS

	Page
I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES.....	1
III. STATUS OF CLAIMS	2
A. <u>Total Number of Claims in Application</u>	2
B. <u>Status of All the Claims</u>	2
1. Claims canceled: 23-25 were withdrawn from consideration and canceled without prejudice for appeal purposes	2
2. Claims pending: 1-22	2
3. Claims allowed: Claims 1 through 11	2
4. Claims rejected: Claims 12 through 22.....	2
C. <u>Claims on Appeal</u>	2
IV. STATUS OF AMENDMENTS	2
V. SUMMARY OF THE INVENTION	2
VI. ISSUE	3
1. Whether broadened reissue Claims 12 through 22 were erroneously rejected under the Recapture Doctrine in view of the facts and file history of the present application, particularly including a change in the applicable law?.....	3
VII. GROUPING OF CLAIMS.....	3
VIII. SUMMARY OF PROSECUTION HISTORY OF THE ORIGINAL PATENT	3
A. First Office Action	4
B. May 14-15, 1997 Interviews.....	5
C. June 9, 1997 Amendment	6
D. Final Office Action	6
E. September 30, 1997 Interview	7
F. Amendment After Final Office Action.....	8
G. Notice of Allowability/Patent Issuance	8
IX. SUMMARY OF THE REISSUE PROSECUTION HISTORY	8
A. First Office Action dated 6-11-01	9
B. Response to the 6-11-01 Office Action	10
C. Replacement Terminal Disclaimer	11

TABLE OF CONTENTS

(continued)

	Page
D. Final Office Action dated 01-29-02	11
E. Examiner Interview	12
X. ARGUMENT	13
A. Recapture Doctrine Is Erroneously Applied Where Congress Changed The Law	13
B. Reissue Laws and the Recapture Doctrine are based in Equity	15
C. The Recapture Doctrine should not be applied to bar the claims of the present reissue application	19
1. The Recapture Doctrine should not be applied to this reissue application because the law has changed so a provisional rejection of the claims of the original application would not be proper after a showing of a common owner or assignee at the time of the invention	19
(a) Patent Law During Prosecution of Original Application	20
(b) Amendment to 35 U.S.C. § 103 (c)	21
(c) Applicability of Amendment to Reissue App. '277	22
(d) USPTO Implementation of Amendment to Section 103(c)	26
(e) Conclusion	31
2. Applying the Doctrine of Recapture Under the Facts of this Case is Against Fundamental Principles of Fairness and Equity	31
(a) The prosecution history of this case shows that the types of errors during the prosecution of the patent that is the subject of the reissue are the types of errors that reissue is designed to correct	31
(b) Under these facts, Applicant did not surrender the scope of the subject matter in the claims present in the reissue application because Applicant did not admit the claims were unpatentable, and an inference of unpatentability cannot be drawn when there was no express admission and the entire prosecution history is analyzed	35
(c) Mistakes that cause the patent to be less protected than what the inventor deserved are what the equity-based decisions of the Supreme Court in the 1800's and the Reissue Statute were designed to remedy	42

TABLE OF CONTENTS
(continued)

	Page
XI. CONCLUSION.....	43
XII. APPENDICES	45
XIII. PRAYER FOR RELIEF	45

TABLE OF AUTHORITIES

	Page
Cases	
<u>Ashley v. Samuel C. Tatum Co.</u> , 240 F. 979 (S.D.N.Y. 1917).....	24
<u>Ball Corp. v. United States</u> , 729 F.2d 1429, 1436, 221 U.S.P.Q. 289 (Fed. Cir. 1984)	18
<u>Ex parte Holt</u> , 214 U.S.P.Q. 381 (Bd.Pat.App.&Int. 1982).....	23
<u>Goodyear Atomic Corp. v. Miller</u> , 486 U.S. 174 (1988).....	27
<u>Grant v. Raymond</u> , 6 Pet. 218, 240-41, 8 L.ED 376 (1832).....	16
<u>Green v. Bock Laundry Mach. Co.</u> , 490 U.S. 504 (1989)	28
<u>Hester Industries, Inc. v. Stein, Inc.</u> , 142 F.3d 1472, 1481, 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998)	16
<u>In re Clement</u> , 131 F.3d 1464, 1468, 45 U.S.P.Q.2d 1161 (Fed. Cir. 1997)	17
<u>In re Haas</u> , 580 F.2d 461, 198 U.S.P.Q 334 (CCPA 1978)	23
<u>In re Kuehl</u> , 475 F.2d 658 (CCPA 1973).....	24
<u>In re Richman</u> , 409 F.2d 269, 276, 161 U.S.P.Q. 359 (CCPA 1969).....	19
<u>In re Rohm & Haas Co. v. Roberts Chemicals, Inc.</u> , 245 F.2d 693 (4th Cir. 1957).....	24
<u>In re Wadlinger</u> , 496 F.2d 1200, 1208-10, 181 U.S.P.Q 826 (CCPA 1974)	23
<u>In re Weber</u> , 580 F.2d 455, 198 U.S.P.Q 328 (CCPA 1978).....	23
<u>In re Weiler</u> , 790 F.2d 1576, 1579, 229 U.S.P.Q. 673, 675 (Fed. Cir. 1986).....	16
<u>In re Wilder</u> , 736 F.2d 1516, 1519, 222 U.S.P.Q. 369, 371 (Fed. Cir. 1984).....	35
<u>In re Willingham</u> , 282 F.2d 353, 354-55, 127 U.S.P.Q 211 (CCPA 1960).....	16
<u>Mentor Corp. v. Coloplast, Inc.</u> , 998 F.2d 992, 995-96, 27 U.S.P.Q.2d 1521, 1524-25 (Fed. Cir. 1993).....	18
<u>Mid Atlantic Nat. Bank v. N.J. Dept. of Env. Prot.</u> , 474 U.S. 494 (1986)	28
<u>Miles v. Apex Marine Corp.</u> , 498 U.S. 19 (1990)	27
<u>Rohm & Haas</u> , 245 F.2d at 699.....	25
<u>Seattle Box Co. v. Industrial Crating & Packing, Inc.</u> , 731 F.2d 818, 826, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984).....	35
<u>Shepard v. Carrigan</u> , 116 U.S. 593, 29 L. Ed. 723 (1886).....	19
<u>Sontag Chain Stores Co., Ltd., v. National Nut Co. of California</u> , 310 U.S. 281, 286-87 (1940) 32	

<u>Topliff v. Topliff</u> , 145 U.S. 156, 171, 12 S.Ct. 825, 831 (1891).....	17
--	----

CERTIFICATE OF MAILING 37 C.F.R. 1.10

"Express Mail" Mailing Label Number: EL901963098US

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office To Addressee" service with sufficient postage on the date indicated below and is address to: Assistant Commissioner for Patents, Washington, D.C., 20231.

Name of Person Signing Certificate: Terrie Lindquist

Date 7/26/02

Terrie Lindquist
Signature

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:

Harrison G. Purvis et al.

Serial No.: 09/703,277

Filed: 10/31/2000

For: TEMPORARY GUARD RAIL
SYSTEM

§
§
§
§
§
§
§
§
§

Confirmation No. 1667

Examiner: Andrea M. Chop

Group Art Unit: 3677

Attorney Docket No.073937.000008
(formerly 24104)

APPEAL BRIEF

This is an appeal from the final rejection of Claims 12 through 22 in the above referenced patent reissue application. The final action is dated January 29, 2002.

APPELLANT'S BRIEF (37 C.F.R. § 1.192)

I. REAL PARTY IN INTEREST

Harrison G. Purvis, Route 1, Box 238D, Holly Springs, North Carolina 27540, as inventor and through assignment of all rights from other co-inventor is the real party in interest of the captioned patent application.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

Twenty-two (22) claims were originally filed in this reissue application. Three (3) claims were added in the Amendment filed on September 10, 2001 in response to the June 11, 2001 non-final Office Action.

B. Status of All the Claims

1. Claims canceled: 23-25 were withdrawn from consideration and canceled without prejudice for appeal purposes.
2. Claims pending: 1-22
3. Claims allowed: Claims 1 through 11.
4. Claims rejected: Claims 12 through 22.

C. Claims on Appeal

Claims 12 through 22.

IV. STATUS OF AMENDMENTS

An Amendment/Response to a final Office Action canceling Claims 23-25 was filed on April 26, 2002. An Advisory Action dated May 14, 2002 acknowledged that the Amendment will be entered for purposes of appeal.

V. SUMMARY OF THE INVENTION

The present invention relates to a temporary guardrail system 10 for a removable attachment to a building under construction. The guardrail system 10 comprises a plurality of upright stanchions 11, an anchor bracket 12 connected to a bottom end of each one of the plurality of stanchions 11, and a plurality of vertically spaced-apart side rails 16 connected to each of the plurality of stanchions 11. The system 10 also comprises means 16c, 18 for rotably connecting the side rails 16 to the stanchions 11 enabling each respective side rail 16 to be rotated about a longitudinal axis of each respective stanchion 11 in a horizontal plane and each

respective side rail to be pivoted at varying angles in a vertical plane. The connecting means includes a first threaded stud 19 outwardly projecting from a top end of the stanchions 11 in substantially axial alignment therewith enabling each of the side rails 16 to be rotably mounted thereon at various angles. The side rails 16 are pivoted in a vertical plane at varying angles. The system 10 also comprises means 16d, 16e for telescopically adjusting the length of each respective side rail 16 enabling the temporary guardrail system 10 to be adapted to dimensional features of different buildings under construction. The system 10 further comprises means 40 for selectively extending the vertical height of the guardrail system 10 for performing specialized tasks.

VI. ISSUE

1. Whether broadened reissue Claims 12 through 22 were erroneously rejected under the Recapture Doctrine in view of the facts and file history of the present application, particularly including a change in the applicable law?

VII. GROUPING OF CLAIMS

Claims 12-22 are grouped with respect to the sole issue set out above. It is suggested that the Board choose Claim 12 as representative of this group.

VIII. SUMMARY OF PROSECUTION HISTORY OF THE ORIGINAL PATENT

The present application is a broadened reissue of U.S. Patent No. 5,842,685 ("the '685 Patent"). The '685 patent was based on U.S. Patent Application Serial No. 08/620,211 filed on March 3, 1996 ("the '211 Application), which was a continuation-in-part application of U. S. Patent Application Serial No. 08/421,858, titled "Temporary Guard Rail System and Method of Using Same" on March 3, 1996. U.S. Patent Application Serial No. 08/620,211 ("the '211

Application") later issued as United States Patent No. 5,842,685 ("the '685 Patent"). Application '211 originally had fourteen (14) claims.

A. First Office Action

Applicant received a first non-final Office Action dated March 3, 1997 ("the 3-3-97 Office Action") rejecting all fourteen (14) claims, namely Claims 1-14, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which Applicant regards as the invention. In paragraph 8, Claims 1-3, 6, 9 and 10 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Applicant's copending U.S. Patent Application Serial No. 08/755,596 ("the copending '596 Application"), in view of U. S. Patent No. 2,136,696 by Lamb ("Lamb '696") and U. S. Patent No. 3,480,257 by Bourn, et al. ("Bourn, et al. '257"). In paragraph 9, Claims 11-14 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-8, 10-13, and 17 of the copending '596 Application in view of Lamb '696, Bourne et al. '257, and U.S. Patent No. 789,242 by Stewart, Jr. ("Stewart, Jr. '242").

In paragraph 7 preceding the obviousness-type double patenting rejections, the Examiner outlined the law regarding this objection and suggested a way to overcome these provisional rejections. The suggestion read as follows,

"A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R.1.78 (d). (Par. 7)."

Claims 1-3, 6, and 9-14 were also provisionally rejected under 35 U.S.C. § 103 (a) as being obvious over copending '596 Application which had a common inventor with the instant application. (See Par. 10 of 3-3-97 Office Action). With respect to the last rejection under

Section 103(a), in paragraph 10 the Examiner went on to say, "Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 102 (e) if patented." The Examiner also states:

"This provisional rejection might be overcome either by a or by showing a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 C.F.R. 1.131."

Following the rejections, there was a section titled "Allowable Subject Matter" which stated, "Claim 1 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112." (*See* Par. 11 of 3-3-97 Office Action). The Examiner also stated that, "Claims 2-14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all the limitations of the base claim and any intervening claims." (*See* Par. 12 of 3-3-97 Office Action).

B. May 14-15, 1997 Interviews

Following the 3-3-97 Office Action, Applicant's prior attorney had telephonic interviews with the Examiner on May 14-15, 1997 ("the May 14-15, 1997 Interviews"). According to the Interview Summary Record, an agreement was reached. The comments regarding the telephonic interview are as follows:

"Applicant called in regards to the Double Patenting Rejection in the Office Action of 3/3/97: Applicant brought to the Examiner's attention that FWC Application 08/755,596 (Parent Application was 08/421,858) and the present Application 08/620,211 are commonly owned by Mr. Purvis (the common inventor between the two Applications). Attached is a printout showing the common ownership. Applicant was informed that this evidence would obviate a double patenting rejection under 102(f)/103 or 102(g)/103; the Applicant was also informed that filing a terminal disclaimer would obviate the remaining double patenting rejection. As an alternative, Applicant was informed that by amending the claims to claim subject matter patentably distinct from the parent Application and not subject to a double patenting rejection, i.e., Claims 4, 5, etc. would obviate any double patenting rejection."

Following the suggestions of the Examiner to overcome the double patenting provisional rejections, on May 15, 1997 Applicant's attorney executed and filed a Terminal Disclaimer to obviate the remaining double patenting rejections with an Amendment filed on June 9, 1997. The Terminal Disclaimer disclaimed the terminal part of the statutory term of any patent granted on the '211 Application, which would extend beyond the expiration date of the full statutory term of any patent granted on the copending '596 Application.

C. June 9, 1997 Amendment

Applicant filed an Amendment on June 9, 1997 ("the 6-9-97 Response") in response to the 3-3-97 Office Action and the May 14-15, 1997 Interviews. As mentioned above, the Terminal Disclaimer to obviate the remaining double patenting rejections was an attachment to the 6-9-97 Response. Applicant amended Claims 1-14 to comply with each and every rejection set forth in the 3-3-97 Office Action in order to comply with 35 U.S.C. § 112, second and sixth paragraphs. (*See* Paragraph 4 on Page 9 of the 6-9-97 Response). Because common ownership was verified during the May 14-15, 1997 interviews, and because Applicant was also submitting the Terminal Disclaimer with the amendments to obviate the double patenting rejections (*See* Paragraph 5 on Page 10 of the 6-9-97 Response) as suggested during the May 14-15, 1997 interviews, Applicant submitted that Claims 1-14 were in condition for allowance. (*See* Paragraph 5 on Page 9 of the 6-9-97 Response).

D. Final Office Action

Applicant received an Office Action dated August 28, 1997 rejecting Claims 1-3, 6, and 9-14, and objecting to Claims 4, 5, 7 and 8. According to paragraph 7, the August 28, 1997 Office Action was a Final Office Action ("the 8-28-97 Final Office Action"). Only Claim 12 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regarded as the

invention. (Par. 2). In paragraph 4, Claims 1-3, 6, and 9-14 were provisionally rejected under 35 U.S.C. 103 (a) as being obvious over Applicant's copending '596 Application, which had a common inventor with the instant application, in view of Lamb '696, Bourn, et al. '257, and Stewart, Jr. '242. In paragraph 3, the Examiner quoted portions of Section 103, one of the portions (which was § 103 (c) in 1997) read as follows:

"Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

In paragraph 4, the Examiner stated, "Based upon the earlier filing date of the copending application, it would constitute prior art under 35 U.S.C § 102 (e) if patented." Then the Examiner continued,

"This provisional rejection might be overcome either by a showing under 37 C.F.R. 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention 'by another,' or by a showing of a date of invention for the instant application prior to the effective date of the copending application under 37 C.F.R. 1.131."

In paragraph 5, only Claims 4, 5, 7 and 8 were included under the heading "Allowable Subject Matter." The Examiner stated that these claims were objected to as being dependent on a rejected base claim, but indicated that they would be allowed if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner did not discuss Claims 1-3, 6, and 9-14 in paragraph 5 under the heading "Allowable Subject Matter."

E. September 30, 1997 Interview

Claims 4, 5, 7 and 8 were discussed between the Examiner and Applicant's attorney during a telephonic interview on September 30, 1997 ("the 9-30-97 Interview"). According to

the comments in the Examiner's Interview Summary Record, Applicant wanted verification that an amendment to the independent claim to include subject matter from Claims 4, 5, 7, or 8 would overcome the Section 102(e)/103 rejection. According to the comments the answer was "yes."

F. Amendment After Final Office Action

On December 2, 1997, Applicant's attorney filed an Amendment After Final Action in response to the 8-28-97 Final Office Action. Claim 1 was amended to include the limitations of Claims 2, 3, and 4. In the first paragraph under the heading "Allowable Subject Matter," Applicant acknowledged with appreciation to the Examiner that Claims 4, 5, 7 and 8 were objected as being dependent on a rejected base claim, but would be allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims. (See Page 3 of the Amendment After Final Action). In the next paragraph, Applicant went on to state, "Accordingly, Applicant has re-written Claim 1 (Twice Amended) to include the patentable limitations of Claim 4 and the intervening Claims 2 and 3 to place Claim 1 in condition for allowance." (See Page 3 of the Amendment After Final Action).

Amending Claim 1, also obviated the Section 102(e)/103 rejection of Claims 6, and 9-14. Claims 2-4 were cancelled after being written into Claim 1 as intervening claims. Applicant also amended Claim 12 to obviate the Section 112 objection.

G. Notice of Allowability/Patent Issuance

A Notice of Allowability was sent to Applicant on December 17, 1997 for remaining Claims 1 and 5-14, which were renumbered as Claims 1-11 in the '685 Patent that issued on December 1, 1998.

IX. SUMMARY OF THE REISSUE PROSECUTION HISTORY

Applicant filed the present Reissue Application Serial No. 09/703,277 ("Reissue App. '277") to broaden the claims of the '685 Patent on October 31, 2000. Included with Reissue App.

'277 was a reissue oath in which Applicant, Harrison Purvis, stated that he believes the '685 Patent to be wholly or partly inoperative or invalid by reason of the patentee claiming more or less than he had a right to claim in the patent. Applicant stated that the error upon which reissue is based is that applicant's attorney failed to appreciate the contribution and scope of Applicant's invention and failed to claim the scope of what Applicant was entitled to claim. Applicant went on to claim error in the fact that Applicant's previous attorney allowed claims to issue which were too narrow. Finally Applicant submitted that such errors arose without any deceptive intent.

In the Reissue App. '277, Applicant resubmitted the original Claims 1-11 that were in the '685 Patent and submitted new Claims 12-22. Claims 12-22 were broader than the claims in the '685 Patent and covered substantially the same scope of subject matter as the claims that were amended in the prosecution of the '211 Application.

A. First Office Action dated 6-11-01

Applicant was informed in an Office Action dated June 11-2001 ("the 6-11-01 Office Action"). In paragraph 5, that Claims 12-22 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to distinctly claim the subject matter of the invention. The Examiner provided Applicant with suggested minor amendments to the claims to obviate this objection.

In paragraphs 6-8, Applicant was also informed that Claims 12-22 were being rejected under the judicially created doctrine of obviousness-type double patenting. The Examiner also stated that a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) could be used to overcome this rejection if the reissue application and the conflicting patent were commonly owned.

In paragraph 9, Applicant was informed that Claims 12-22 were rejected under 35 U.S.C. § 251 "as being improper recapture of claimed subject matter surrendered in the application for the patent upon which the present reissue is based." The Examiner went on to state that a broadening aspect is present in the reissue which was not present in the application for patent, and that the record shows that the broadening aspect relates to subject matter previously surrendered during prosecution. The Examiner continued by saying that the narrow scope was not an error within the meaning of Section 251, and the broader scope cannot be recaptured by the filing of the present application.

The Examiner noted the limitations that were missing from Claims 12-22 and stated that these limitations were added to overcome the 102(e)/103 rejection based on the 9-30-97 Interview. Due to the 9-30-97 Interview, the Examiner concluded that the broader scope had been surrendered and could not be recaptured in the reissue application.

In paragraphs 10-12 under the heading "Allowable Subject Matter," the Examiner noted that Claims 1-11 were allowable over the prior art. The Examiner also stated that Claims 12-22 would be allowable if they were amended to overcome the Section 251 rejection, and the double patenting rejection.

B. Response to the 6-11-01 Office Action

Applicant included with the response another copy of the reissue oath or declaration, a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) to obviate the double patenting rejection, and a 37 C.F.R. § 1.132 declaration stating that the application for the invention disclosed in the '074 Patent (the patent issued to the copending '596 Application) was copending with the application for the invention disclosed in the '685 Patent, and was derived by common inventors.

Applicant added method Claims 23-25 to the Reissue App. '277 in the response to the 6-11-01 Office Action. Applicant attempted to make the corrections that the Examiner suggested in order to obviate the Section 112 rejection.

Applicant argued that Claims 12-22 were being improperly rejected under Section 251 because the Recapture Doctrine should not apply in light of the error committed by the Applicant's previous attorney in choosing to narrow the claims in the original application instead of submitting a declaration in compliance with 37 C.F.R. § 1.132. Applicant respectfully submitted that amendments are not dispositive that claims are unpatentable, and reminded the Examiner that proof of an admission that the scope of the claims was unpatentable is required in order for the Recapture Doctrine to be applicable.

C. Replacement Terminal Disclaimer

On November 7, 2001, Applicant submitted a replacement Terminal Disclaimer after inventor Matthews was added to the application (because of the addition of Claims 23-25) so that Matthews was also terminally disclaiming the '074 Patent.

D. Final Office Action dated 01-29-02

Applicant received a Final Office Action dated January 29, 2002 ("the 1-29-02 Final Office Action"), which informed Applicant that Claims 1-11 were allowed. In paragraph 3, the Examiner informed Applicant that Claims 23-25 were directed to an independent or distinct invention, that Claims 1-22 were constructively elected for prosecution, and that Claims 23-25 were being withdrawn from consideration as being directed to a non-elected invention.

In paragraph 4, the Examiner informed Applicant that Applicant did not comply with the requirements of 37 C.F.R. § 1.48 (c) to change inventorship. The Examiner provided Applicant with the portions of Section 1.48 (c) that Applicant needed to rectify in order to be in compliance with the requirements of Section 1.48 (c).

In paragraph 6, the Examiner rejected Claims 12-22 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The Examiner states that a broadening aspect is present in the reissue which was not present in the application for patent. According to the Examiner, the prosecution history of the patent upon which the present reissue is based, shows that the broadening aspect (in the reissue application) relates to subject matter that Applicant previously surrendered during prosecution of the application. The Examiner then concluded that the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. § 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The Examiner pointed out that Claims 12-22 do not contain the language that was added in the December 2, 1997 Amendment After Final Action. The Examiner stated that based on the 9-30-97 Interview, these limitations were added to the claims to overcome the Section 102(e)/103 rejection, and thus the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

E. Examiner Interview

The Recapture Doctrine rejections in the 1-29-02 Final Office Action Final were discussed during an interview on April 8, 2002 ("the 4-8-02 Interview"). The participants in the 4-8-02 Interview were the Examiner, the Supervising Examiner, an Examiner who was represented as having considerable reissue experience, and Applicant's new attorney. According to the comments of the Examiner's Interview Summary Record, the rejection based upon the Recapture Doctrine was the main topic of the interview, and Applicant's attorney continued to argue that the Recapture Doctrine does not apply in this case due to the change in law, the errors which occurred, and no admission by Applicant that broader scope not patentable.

The Examiners and Applicant's attorney discussed the problem with applying the Recapture Doctrine to bar subject matter that was rejected under a law that has subsequently been amended so that such a rejection would not be applicable to an application filed today. The Examiners and Applicant's attorney also discussed that the Recapture Doctrine is an equitable doctrine. Applicant's attorney discussed with the Examiners that the Recapture Doctrine is not applicable to Reissue App. '277 since neither the Applicant nor Applicant's previous attorney ever admitted that Applicant was not entitled to the broader scope in the provisionally rejected claims.

An agreement was not reached during the 4-8-02 Interview. Applicant's attorney was informed that the Examiners were applying the Recapture Doctrine as they are instructed under USPTO policies, and that they did not have the authority to make their own equitable determinations and would not address the change in law issue. Applicant's attorney was informed that an equitable determination would have to be made by the Board of Patent Appeals and Interferences, or by a court.

X. ARGUMENT

A. Recapture Doctrine Is Erroneously Applied Where Congress Changed The Law

The rejections at issue in this case were provisional rejections, based on a co-pending, commonly owned application under old Section 103(c) and double patenting for which a Terminal Disclaimer overcomes. The law has changed so the co-pending commonly owned application is no longer available as a basis for any Section 103(c) rejection. The Recapture Doctrine clearly is not applicable when Congress changes the law as to what can be used as prior art, as has been done here. See In re Wadlinger, 496 F.2d 1200, 1208-10, 181 U.S.P.Q. 826 (CCPA 1974). Applicant is not seeking to claim subject matter which the Examiner indicated

was unpatenable over prior art which is still available as prior art and to which Applicant acquiesced. Because of the change to Section 103(c), the Section 103(c) rejection is no longer applicable, and there is no other Section 103 rejection involved here. The claims sought on reissue here were indicated to be allowable by the Examiner. The prior attorney either erroneously thought the Terminal Disclaimer would solve the Section 103 rejection problem or submitted an erroneous response to overcome the Section 103 rejection now no longer available. Applicant should not be punished for this error.

A remedial tool exists that is designed to remedy situations in which a patent protects less than Applicant was entitled because an error during the prosecution was committed by Applicant, an Examiner, or an attorney or agent for an applicant, or any combination thereof. That remedial tool is a reissue application. In essence, a broadened reissue application is a two-year warranty from the USPTO that allows patentees to take defective patents back to the USPTO within the two-years so that the error causing the defect can be rectified.

The Recapture Doctrine is a tool that prevents an applicant from perpetrating a fraud against society by intentionally limiting his application in order to make it patentable around prior art, and then later arguing that invention is actually novel around the prior art. The USPTO policies regarding the rules of applying the Recapture Doctrine should be based upon fundamental principles of equity and fairness in order to protect both the inventors and the public. The current USPTO guidelines, however, do not allow much leeway for Examiners to look to the facts surrounding each case and determine when fundamental principles of equity and fairness demand that the Recapture Doctrine should not be applied, especially where a change of law has occurred.

In the present case, the current claims for Applicant's invention cover subject matter that the Examiner indicated was of sufficient novelty that, without amendment, was patentable upon filing a statement saying that Applicant was also the inventor of the disclosed but unclaimed subject matter of the copending '596 Application bearing Applicant's name. Applicant's prior attorney during the original prosecution chose to amend the claims, rather than showing under 37 C.F.R. 1.132 that any invention disclosed but not claimed in the copending '596 Application was derived from the inventor of the '211 Application and is thus not the invention by another under 35 U.S.C. § 102 (e), and therefore not a valid reference for the Section 103 obviousness-type rejection. This is a mistake that has made Applicant lose the right to protect the full extent of his patentable invention. Applicant is now asking that the error committed by Applicant's prior attorney be remedied under the remedial procedures of a broadened reissue patent. Applicant filed his application within the two-year requirement for broadening the scope of claims. But now the Examiner is saying that the error is not something that is correctable under current USPTO policies.

The purpose of the Recapture Doctrine is to protect society from an inventor fraudulently making an amendment to obtain a patent around prior art, and then later trying to argue that the prior art does not disclose or make obvious his invention. That is not what Applicant is trying to do in Reissue App. '277. Applicant is merely trying to obtain protection for that which the Examiner for the USPTO has already said was useful, novel, patentable, and protectable, especially in view of the change in the law by Congress.

B. Reissue Laws and the Recapture Doctrine are based in Equity

Section 251 of Title 35 of the United States Code, entitled "Reissue of Defective Patents," states:

"Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and part of the term of the original patent. No new matter shall be introduced into the application for reissue."

Section 251 (hereinafter "the Reissue Statute") and the application of the Recapture Doctrine are "based upon fundamental principles of equity and fairness" and should be applied to the facts of any given case so that justice will be done both to the patentee and to the public. Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 1481, 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998), *citing* In re Weiler, 790 F.2d 1576, 1579, 229 U.S.P.Q. 673, 675 (Fed. Cir. 1986); In re Willingham, 282 F.2d 353, 354-55, 127 U.S.P.Q. 211 (CCPA 1960). The approach in Hester dates back to Supreme Court decisions as far back as the early 1800's. In 1832, Chief Justice Marshall outlined the purpose of reissue and how it fits within the patent laws in Grant v. Raymond, as follows:

"The great object and intention of the (Patent) act is, to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals, for the time and labor devoted to these discoveries, by the exclusive right to make, use and sell the things discovered, for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error, which are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act."

6 Pet. 218, 240-41, 8 L.Ed. 376 (1832) (as *quoted in* In re Willingham, 282 F.2d at 730).

As communicated by Chief Justice Marshall, the Patent Laws convey to the inventor a temporary monopoly in an invention as consideration for teaching the public the science behind the invention. Chief Justice Marshall went on to consider the consequences of the absence of reissue to patentees if there were a mistake during the prosecution of the patent:

"...The communication of the discovery to the public has been made in pursuance of the law, with the intent to exercise a privilege which is the consideration paid by the public for the future use of the machine. If, by innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery, without paying the stipulated consideration. The attempt would be disreputable of an individual, and a court of equity might interpose to restrain him." Grant, 6 Pet. at 240-41.

Almost sixty years later, the Court continued to maintain its position that equity demands protection for the inventors. See Topliff v. Topliff, 145 U.S. 156, 171, 12 S.Ct. 825, 831 (1891). Before the passage of Section 35 U.S.C. § 251, the reissue statute, Mr. Justice Brown expressed similar concerns to those of Chief Justice Marshall, regarding errors committed by attorneys and agents in claiming the scope of an invention, while warning that the facts of each case and not strictly following a rule should control, when he stated the following:

"The specification and the claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy; and, in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure him his actual invention, provided it is evident that there has been a mistake and he is guilty of no want of reasonable diligence in discovering it... The object of the patent law is to secure to the inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by too strict and technical adherence to the letter of the statute, or by application of artificial rules of interpretation."

Topliff, 145 U.S. 156, 171, 12 S.Ct. 825, 831 (1891) (as quoted in In re Willingham, 282 F.2d at 731).

The Recapture Doctrine, on the other hand, prevents a patentee from regaining through reissue subject matter that he surrendered in an effort to obtain allowance of original claims. Hester, 142 F.3d at 1480; In re Clement, 131 F.3d 1464, 1468, 45 U.S.P.Q.2d 1161 (Fed. Cir. 1997). This rule is rooted in the 35 U.S.C. § 251 "error" requirement in that such surrender is

not the type of correctable error contemplated by Section 251. Hester, 142 F.3d at 1480. An attorney's failure to appreciate the full scope of the invention qualifies as an error under Section 251 and is correctable by reissue. In re Clement, 131 F.3d at 1468; Hester, 142 F.3d at 1479-80.

The Court of Appeals for the Federal Circuit set out a two-step test for guidance regarding the Recapture Doctrine. In re Clement, 131 F.3d at 1468-69. This two-step test is provided in the Manual of Patent Examining Procedure ("MPEP") in Section 1412.02. Determining whether an applicant has met the statutory requirements of 35 U.S.C. § 251 is a question of law which is based upon the underlying facts of the case. In re Clement, 131 F.3d at 1468.

The Federal Circuit went on to say that the first step in applying the Recapture Doctrine is to determine whether and in what aspect the reissue claims are broader than the patent claims. In re Clement, 131 F.3d at 1468. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Id. at 1468-69. To determine whether an applicant surrendered particular subject matter, the reviewing body looks to the prosecution history of the patent that is the subject of the reissue for arguments and changes made to the claims made in an effort to overcome a prior art rejection. In re Clement, 131 F.3d at 1469, *citing* Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995-96, 27 U.S.P.Q.2d 1521, 1524-25 (Fed. Cir. 1993), *and citing* Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289 (Fed. Cir. 1984).

The claims in the Reissue App. '277 are broader than the claims in the '685 Patent. In this situation, the Examiner must next determine whether the broader aspects of that reissue claim relate to subject matter that applicant previously surrendered during the prosecution of the original application for the patent that is the subject of the reissue application. MPEP § 1412.02

C. The Recapture Doctrine should not be applied to bar the claims of the present reissue application.

In view of the above, there are at least two main reasons why Claims 12 through 22 of this reissue application should not be barred under the Recapture Doctrine. First, it is inappropriate and contrary to fundamental principles of equity and fairness to apply the Recapture Doctrine because the law regarding the provisional rejection of the claims of the original application has changed so that such a rejection would not be proper at this time. Second, under the facts of this application it is inappropriate and contrary to fundamental principles of equity and fairness to apply the Recapture Doctrine.

1. The Recapture Doctrine should not be applied to this reissue application because the law has changed so a provisional rejection of the claims of the original application would not be proper after a showing of a common owner or assignee at the time of the invention.

In In re Richman, 409 F.2d 269, 276, 161 U.S.P.Q. 359 (CCPA 1969), the court compared their facts to the situation the Supreme Court faced in Shepard v. Carrigan, 116 U.S. 593, 29 L. Ed. 723 (1886), for guidance while addressing the rationale behind the Recapture Doctrine, and it stated the following:

"Referring back to Shepard, however, it is apparent that the situation there was one which the omission of the added limitation would have resulted in the claim being drawn to the same subject matter as the original claim, to which the limitation was added, thus making it unpatentable over the prior art for the same reason as the original claim." 409 F.2d, at 1089.

This is the dilemma that faces most applicants if they were to try to have their claims reissued to the same, or substantially the same scope as the claims that were originally prosecuted. Applicant's situation, however, is different than most other applicants because all the claims in the Reissue App. '277 are patentable over the prior art because of an amendment to the patent laws. In Applicant's situation, Section 103 (c) changed so that if the inventions of copending applications were commonly owned or under an obligation of assignment to a

common person, then the copending application is not available as Section 102 (e) prior art in an obviousness rejection.

(a) Patent Law During Prosecution of Original Application

During the prosecution of the '211 Application, Claims 1-3, 6, and 9-14 were provisionally rejected in both the 3-3-97 Office Action and the 8-28-97 Final Office Action as being obvious over the copending '596 Application, which had a common inventor with the instant application, in view of Lamb, Bourn et al. and Stewart, Jr. In paragraph 3 of the 8-28-97 Final Office Action, the Examiner provided the pertinent subsections of 35 U.S.C. § 103 which were the statutory basis for the provisional rejections. The subsections of Section 103 that the Examiner cited were subsections (a) and (c). In 1997, subsections (a) and (c) of Section 103 were as follows:

Section 103 Conditions for patentability; nonobvious subject matter

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

...

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. 103.

Applicant's prior attorney during the prosecution of the '685 Patent, attempted to obviate the obviousness-type double patenting objections from the 3-3-97 Office Action by showing common ownership (*See* summary of the May 14-15, 1997 Interview) and by filing the Terminal

Disclaimer (see Exhibit C), which in and of itself provides evidence of common ownership. Under Section 103 (c) as it was in 1997, a showing that any invention disclosed but not claimed in the copending application (08/755,596) was derived from the inventor of this application (08/620,211) prevented the copending application from being an invention "by another" under Section 103 (c). *See* 08-29-97 Final Office Action, paragraph 4; 03-03-97 Office Action, paragraph 7. After such a showing, the first application could not be used as prior art against the second application because the copending inventions were commonly owned. The Lamb, Bourne et al., and Stewart, Jr. patents did not teach all of the elements of the invention in the '211 Application. Therefore, if Applicant's attorney had made such a showing in the prosecution of the '211 Application, there would no longer be a valid Section 103 objection prior art because the copending '596 Application was necessary to make the invention in the '211 Application obvious.

(b) Amendment to 35 U.S.C. § 103 (c)

After the prosecution of the '211 Application and before the filing of Reissue App. '277, Section 103 (c) was amended by Congress. On November 29, 1999, during the first session of the 106th Congress, 35 U.S.C. § 103 was amended. Pub. L. 106-113 § 4807 (a), 113 Stat. 1501. After the 1999 amendment, subsection (a) remained as it was in 1997, but subsection (c) read as follows:

(c) Subject matter developed by another person, which qualifies as prior art only under *one or more of subsections (e), (f), and (g)* of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. § 103 (c) (emphasis added).

Following the amendment of Section 103 (c), Section 706.02(k) of the MPEP was amended by adding that a provisional rejection of the obviousness type under 35 U.S.C. 102(e)/103 is overcome with:

"(E) For an application filed on or after November 29, 1999, showing that the prior art and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

There has been a showing that the '211 Application and the cited '596 Application were owned by Applicant as far back as the May 14-15 Interviews. The Examiner has already verified and admitted in the comments of the Interview Summary that common ownership existed at the time the invention was made. Therefore, the requirements of MPEP § 706.02(k)(E) were met even before the 08-29-97 Final Office Action.

(c) Applicability of Amendment to Reissue App. '277

Under amended or new Section 103 (c), Section 102 (e) rejections shall not preclude patentability where the subject matter (of the prior copending application) and the claimed invention were, at the time the second invention was made, owned by the same person or subject to an obligation of assignment to the same person. According to Pub. L. 106-113 § 4807 (b), this amendment was effective as of November 29, 1999, the date of its enactment. Therefore, the Reissue App. '277 should be examined based upon the amended Section 103 (c) because the Reissue App. '277 was filed after the effective date of the amendment.

In addition to the statute mandating that the law at the time of the reissue should be applied to applications filed after its November 29, 1999 effective date, the CCPA and the Board have both ruled that a reissue application is prosecuted based on the law at the time of the reissue, rather than the law at the time of the prosecution of the original patent. According to In re Wadlinger and Ex parte Holt, the law at the time of the reissue is the law that is to be applied,

instead of the law at the time of the prosecution of the original patent. Ex parte Holt, 214 U.S.P.Q. 381 (Bd.Pat.App.&Int. 1982); In re Wadlinger, 496 F.2d 1200, 1208-10, 181 U.S.P.Q. 826 (CCPA 1974). In the case of Ex parte Holt, the Board of Patent Appeals and Interferences faced a situation in which an Examiner had rejected an applicant's "Markush" claims. Holt, 214 U.S.P.Q. at 382. After the prosecution of the patent, the applicant realized that his attorney had not appreciated that the Examiner's rejection was improper. Holt, 214 U.S.P.Q. at 383. In reversing the Examiner's rejection of the appeal claims, the Board noted that In re Weber, 580 F.2d 455, 198 U.S.P.Q. 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 U.S.P.Q. 334 (CCPA 1978) made the Examiner's rejection improper. Holt, 214 U.S.P.Q. at 383. The Board found that the facts were analogous to In re Wadlinger, and held that the "Markush" claims should be analyzed under the law after In re Weber instead of the law during the prosecution of the original examination. Holt, 214 U.S.P.Q. at 383-84 and 385-386.

Likewise, in In re Wadlinger, after canceling a set of claims in response to a prior art rejection, the applicants realized that the compositions that were under the scope of the cancelled claims exhibited unique properties, and thus should have been included in the scope of the patented claims. 496 F.2d, at 1202. The applicants filed a reissue application, which the Examiner and the Board of Patent Appeals and Interferences rejected because the applicant's deliberate cancellation of claims similar in scope in the original case does not involve error within the meaning of 35 U.S.C. § 251. In re Wadlinger, 496 F.2d at 1202. Part of the basis for the Examiner's and the Board's rejections of the reissue claims under both 35 U.S.C. § 103 and § 251 was an alleged insufficiency of the applicant's showing of unexpected results of the subject matter of the reissue claims. Id. at 1209.

The court noted that the Examiner and the Board were applying the law as it was before their decision in In re Kuehl, 475 F.2d 658 (CCPA 1973), to find that the invention defined by the reissue claims was obvious under Section 103, and found no error under Section 251. In re Wadlinger, 496 F.2d at 1208. With respect to the Section 103 rejection, the court stated that "the change in the law brought about by Kuehl, in overruling of In re Saunders, means that in applying the standards of § 103 to the appealed claims we need not consider whether appellants have established unexpected superior results...because under Kuehl they need not show such results." In re Wadlinger, 496 F.2d at 1208 (citations omitted).

Regarding the issue of error under Section 251, the court concluded that "since on the § 103 issue appellants would not today, after Kuehl, have to show unexpected properties, there is no basis for requiring such a showing to establish error within § 251." In re Wadlinger, 496 F.2d at 1208. The court went on to state:

"It is clear that the patentability of reissue claims is determined by the application of the law which exists during the prosecution of the reissue application rather than the law at the date of the issuance of the original patent, where there has been a change in the law since then."

In re Wadlinger, 496 F.2d at 1208.

Both In re Wadlinger and Holt were cases that showing the effects of changes to the Patent Laws after changes brought about by judicial determinations. But the court in In re Wadlinger found support for this from cases discussing statutory and regulatory changes dating back to 1917. In re Wadlinger, 496 F.2d at 1208-10, *citing* In re Rohm & Haas Co. v. Roberts Chemicals, Inc., 245 F.2d 693 (4th Cir. 1957); Ashley v. Samuel C. Tatum Co., 240 F. 979 (S.D.N.Y. 1917).

In Rohm & Haas, the Fourth Circuit Court of Appeals was considering the validity of a reissued patent applied for more than nine years after the original patent. The court said that the

reissued patent was granted on November 24, 1953, after the effective date of the statute (1953 Patent Act), and the validity of the reissue should be construed in light of its provisions. Rohm & Haas, 245 F.2d at 699. Applicant's situation is like that in Rohm & Haas. After the issue of the original patent, the Patent Laws have been amended. Like Rohm & Haas, the validity of the reissue should be construed in light of the amended statute's provisions.

In re Wadlinger also relied on Ashley, which is a case in which the court considered the effects of a change in USPTO rules pertaining to design patents after the original patent was issued and before the reissue application was filed. Ashley, 240 F. at 980. The change in USPTO rules allowed the applicant to claim his object as shown and described, rather than only as shown. Ashley, 240 F. at 280. The scope of the claim became broader by claiming the description in the patent in addition to the figures. Ashley, 240 F. at 282. The court upheld the validity of the descriptions added to a design patent that were not allowed during the prosecution of the original patent, but later allowed when the Patent Office rule changed to provide for a written description in a design patent. Ashley, 240 F. at 282.

Like In re Wadlinger, the law has changed regarding the validity of the Section 103 provisional rejection to Applicant's Claims 1-3, 6, and 9-14 during the prosecution of 08/620,211, because of the amendment to Section 103 (c). According to In re Wadlinger, the amended 35 U.S.C. § 103 (c) is the law that should be used in determining the validity of the reissue claims.

When looking at the reissue claims under the amended Section 103 (c), from the Examiner Interview Summary of the May 14-15, 1997 Interviews, the commonality of ownership by Applicant was shown. Therefore, there is no longer a grounds for obviousness-type double patenting rejection of Claims 1-3, 6, and 9-14 due to the invention in the copending

'596 Application being necessary prior art under Section 102 (e) to make the invention obvious under Section 103, and the commonality of ownership at the time of the invention of the subject matter of the '211 Application has already been established. Therefore, under the amended Section 103 (c), the provisional rejection of Claims 1-3, 6, and 9-14 is improper, and the Examiner's rejection should be reversed.

Furthermore, such a ruling is entirely consistent with the rationale of the court in In re Richman. Recall that in In re Richman, if the omission of the limitation that was placed in the original claims to obtain the original patent were allowed in the reissue claims, they would still be unpatentable over the prior art for the same reason as the original claim. 409 F.2d, at 1089. Reissue is not a venue for reopening prosecution, and in most situations that is exactly what would occur but for the Recapture Doctrine. In Appellant's situation, however, the prior art provisional rejection to Claims 1-3, 6, and 9-14 no longer exists. Therefore, Appellant is not asking for the Examiner to reopen prosecution on those claims so that Appellant can argue around the provisional rejection. Rather, the Appellant is simply asking for the scope of protection that Appellant is entitled to under the laws existing at the time of the reissue application. Also, absent this rejection, the Examiner in both the original and reissue cases indicated that the broader claims would be allowable.

(d) USPTO Implementation of Amendment to Section 103(c)

The USPTO guidelines which became the standard in the MPEP say that for reissue applications filed after November 29, 1999, Section 103 (c) applies. *See* MPEP 706.02 (I) (1). The MPEP Section 706.02 (I) (1), however, also states that, "For reissue applications, the doctrine of recapture may prevent the presentation of claims that were cancelled or amended to overcome such prior art applied in the application which matured into the patent for which

reissue is being sought." (Emphasis added). Based on this statement, it is the Examiner's position that this means that the Recapture Doctrine is applicable to Reissue App. '277.

Applicant does not agree. The statement in Section 706.02 (I) (1) first shows that the Recapture Doctrine does not have to be applied to a Reissue Application after the amendment to 35 U.S.C. § 103 (c), but rather "may" apply. Which means that there must be situations in which the Recapture Doctrine does not apply as in the present case. In light of the holdings of Holt, In re Wadlinger, Rohm & Haas, and Ashley, the Recapture Doctrine should not prevent Applicant from benefiting from the changes to Section 103 (c) because the Patent Laws have changed to expressly provide inventors with a way of disqualifying Section 102(e) prior art used for an obviousness type rejection under Section 103 when copending application was commonly owned or assigned at the time the invention was made.

But MPEP Section 706.02 (I) (1) states that the Recapture Doctrine applies "if the claims were amended or cancelled to distinguish the claimed invention from 35 U.S.C 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made." This policy from the USPTO is inconsistent with both the statute and the case law.

The amendment to Section 103 (c), Pub. L. 106-113 § 4807, does not discuss the Recapture Doctrine, nor is there any implication that the Recapture Doctrine is provided as a way of preventing inventors from benefiting from the amendment. The legislative history of Pub. L. 106-113 § 4807 and the American Inventors Protection Act is silent as to the application of the Recapture Doctrine to reissue applications seeking the protections provided by Congress to inventors from the amendment. Under the Canons of Statutory Construction, we are to assume that Congress is knowledgeable about existing law when it passes legislation. Miles v. Apex Marine Corp., 498 U.S. 19 (1990); Goodyear Atomic Corp. v. Miller, 486 U.S. 174 (1988).

Allowing reissue applicants to benefit from changes in the Patent Laws, either by statute or court decisions, between the original application and the reissue application is a judicially created concept. If Congress intends for legislation to change the interpretation of a judicially created concept, it must make that intent specific. Mid Atlantic Nat. Bank v. N.J. Dept. of Env. Prot., 474 U.S. 494 (1986). Furthermore, a party contending that the legislative action changed settled law has the burden of showing that Congress intended such a change. Green v. Bock Laundry Mach. Co., 490 U.S. 504 (1989). In Applicant's situation, the USPTO appears to be trying to impose different standards of how to apply changes in the law than the standards which the courts have applied. Therefore, the USPTO has the burden of showing that Congress intended to overrule Holt, Wadlinger, Rohm & Haas and Ashley with the amendment to Section 103 (c).

The amendment to Section 103 (c) occurred after each of the cases above that did not apply the Recapture Doctrine but rather allowed the inventors to benefit through reissue from changes in the Patent Laws. Therefore, because the language of the amendment does not contradict these holdings, and because the legislative history of the amendment is silent, the amendment should be construed in light of the Holt, In re Wadlinger, Rohm & Haas, and Ashley.

Additionally, Title 37 of the Code of Federal Regulations, which establishes regulations to implement statutes from Congress, also does not speak to using the Recapture Doctrine to prevent an inventor having a reissue application filed after November 29, 1999 from benefiting from the Section 103 (c) amendment. The USPTO recognized that reissue applications are covered by the amendment to Section 103 (c). See MPEP 706.02 (I) (1); "Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102 (g) and 103 (c) and the Interpretation of the Term 'Original Application' in the American Inventors Protection Act of 1999," 1233 O.G. 54 (April 11, 2000) (hereinafter "the Guidelines") (Both only stating that the changes do not affect

applications filed before November 29, 1999, requests for reexamination, or requests for continued examination, while not excluding reissues). When the USPTO published how it was going to implement the changes to 35 U.S.C. § 103 (c), the USPTO stated in the Guidelines:

"The significant features resulting [from] this amendment to 103 (c) are the following:

(1) Subject matter which was prior art under prior 35 U.S.C. 103 (c) via 102 (e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2)...For reissue applications, the doctrine of recapture may prevent the presentation of claims that were cancelled or amended to overcome such prior art applied in the application which matured into the patent for which reissue is being sought. See (4) below for further explanation.

(4) The recapture doctrine may prevent the presentation of claims in reissue applications that were amended or cancelled from the application which matured into the patent for which reissue is being sought, if the claims were amended or cancelled to distinguish the claimed invention from 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made."

This is the first time that the Recapture Doctrine is said to preclude inventors seeking reissue from benefiting from the amendment of Section 103 (c), even after Congress did not expressly or impliedly state such a desire to overrule over eighty-years of case law stating that reissue applicants can benefit from changes in the law between the time of the prosecution of the original and reissue applications. The Guidelines did not proffer any rationale for the USPTO's policy, and there was not any rationale provided during the comment phase following the initial publication of the Guidelines. Nonetheless, the Guidelines became the policy of the USPTO found in MPEP Section 706.02 (I) (1).

Throughout the course of the 4-8-02 Interview the Examiners continued to state that they had to apply the Recapture Doctrine in this case because it was mandated by the USPTO policies

(presumably in MPEP 706.02 (I) (1) that came from the Guidelines). Once again, the participants in the 4-8-02 Interview were the Examiner, the Supervising Examiner, an Examiner who was represented as having considerable reissue experience, and Applicant's new attorney. The Examiners could not espouse the rationale for applying the Recapture Doctrine in a manner inconsistent with the statute and the case law after the amendment to Section 103 (c). Furthermore, the only response after Applicant's new attorney showed the Examiners the Holt and In re Wadlinger cases, was though Applicant may be correct here they had to follow the USPTO policy and that this policy could only be changed by the Board.

Adding even further confusion, the new MPEP Section 706.02 (I) (1) from the Guidelines says that the Recapture Doctrine may apply, but the MPEP does not provide situations or analysis for determining when the Recapture Doctrine should not apply to reissues applied for within the two-year bar and after November 29, 1999, having common owners, and that had been rejected due to Section 102(e)/103 obviousness under the old 35 U.S.C. § 103 (c). The only standards provided for determining whether the Recapture Doctrine should apply are under the normal Recapture Doctrine policies found in MPEP Section 1412.02. Interestingly, even though Section 1412.02 of the MPEP cites In re Wadlinger when defining what the Recapture Doctrine is, this section does not mention taking into consideration any changes in the Patent Laws between the original application and the reissue application. Clearly, if the USPTO cites the Wadlinger case for one point, it must accept the precedent set forth in the rest of the case as well. Furthermore, as will be discussed in the next section, Section 1412.02 of the MPEP does not provide the Examiners with the authority to make equity-based determinations as to when to apply the Recapture Doctrine.

(e) Conclusion

The USPTO has promulgated rules in the MPEP after the amendment of 35 U.S.C. § 103 (c) that directly conflict with the protections provided to inventors by Congress and by the Courts by stating that the Recapture Doctrine can govern over the amendment to the statute passed by Congress. Besides the obvious Constitutional implications of such an act, such a policy is manifestly unfair and is contrary to fundamental principles of equity and fairness to apply the Recapture Doctrine to the exact situation (common owner of the invention at the time of the invention) that the amended 35 U.S.C. § 103 (c) addresses. Accordingly, for this reason alone, the application of the Recapture Doctrine under the facts in Applicant's situation is improper.

2. Applying the Doctrine of Recapture Under the Facts of this Case is Against Fundamental Principles of Fairness and Equity.

- (a) The prosecution history of this case shows that the types of errors during the prosecution of the patent that is the subject of the reissue are the types of errors that reissue is designed to correct.**

As an additional reason in the present case, the facts dictate against applying the Recapture Doctrine based upon fundamental principles of fairness and equity. In balancing the interests of the inventor and the public, the last paragraph of 35 U.S.C. § 251 provides additional protection for the public by providing that "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." Applicant's Reissue App. '277 was applied for within the two years outlined in Section 251. Therefore, the public is being protected according to the provisions of Section 251 from Applicant trying to acquire his rights after waiting too long to rectify the errors. In considering whether equity and fairness would be served to both the patentee and the public, the

main concern should be whether the error alleged by Applicant prevented him from securing the protections for what he actually invented.

As the Court outlined in Shepard, equity and fairness demand that an inventor who is compelled by a rejection to narrow his claim, should not be able to reapply for that which he was compelled to give up during the original prosecution. Shepard, 116 U.S. at 597. Equity and fairness demand this result because another person is free to look at the prosecution history and will see from the prosecution history that the added limitation was *compelled* because the subject matter was not patentable without the limitation. Sontag Chain Stores Co., Ltd., v. National Nut Co. of California, 310 U.S. 281, 286-87 (1940). The Court, however, also noted that "a clear mistake, or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim." Sontag, 310 U.S. at 289.

As mentioned before, the amendments in the '211 Application were not *compelled*, but rather the Examiner indicated the claims were patentable subject matter, and Applicant has sought reissue speedily within two-year limit imposed by Section 251. Therefore, the acts by Applicant's attorney were a clear mistake and the reissue application was speedy, which makes Applicant's application more like the situation of an error described in Sontag rather than like the compelled rejections in Shepard.

In the prosecution of the '211 Application, the number and type of errors make the application of the Recapture Doctrine inequitable in this situation. The prosecution history of the '211 Application shows a series of errors and mistakes that caused the '211 Application to ultimately issue into a wholly or partly inoperative patent, by reason of the patentee, through Applicant's prior attorney's mistake, claiming less than he had a right to claim. For example, in paragraphs 11-12 of the 3-3-97 Office Action, the Examiner indicated that all of the claims were

of allowable subject matter and provided the way to get them in condition for allowance. The Examiner, however, did not mention anything in these paragraphs about overcoming the obviousness-type double patenting provisional rejections. Applicant's prior attorney should have asked the Examiner for clarification, but did not. Then during the May 14-15, 1997 Interviews, according to the Examiner's own Interview Summary, the Examiner appeared to tell the attorney that submitting a Terminal Disclaimer would obviate the remaining obviousness-type double patenting rejection.

Though Applicant's prior attorney should have discovered that the solution proffered during the May 14-15, 1997 Interview was not the only requirement for the rejection under the combination of Sections 102(e) and 103, Applicant's prior attorney did make a bona fide effort to perform the requirements, as explained by the Examiner during the interview, in order to obviate all the rejections. After Applicant's prior attorney made attempts to comply with the Examiner's instructions, in the 8-28-97 Final Office Action the Examiner stated for the first time that only Claims 4, 5, 7, and 8 were patentable.

After the 8-28-97 Final Office Action, Applicant's prior attorney had a series of options available to him. Applicant's prior attorney could have objected that the 8-28-97 Office Action was improperly made final, the attorney could have appealed the rejection, the attorney could have filed a continued prosecution application, the attorney could have submitted the 37 C.F.R. § 1.132 Declaration, or the attorney could have amended the claims. Under Sections 714.12 and 714.13 of the MPEP, neither entry of a 37 C.F.R. § 1.132 Declaration to obviate the inventorship issue nor the entry of amendments to claims is a matter of right. In fact, generally Section 1.132 Declarations are not timely if filed after a Final Office Action in which no new objections or rejections are presented. MPEP § 716.01.

Furthermore, even though the Examiner said that a 37 C.F.R. § 1.132 Declaration could be used to obviate the 102(e)/103 rejection, this was not listed as an option as to how to make the claims allowable under the section entitled "Allowable Subject Matter." Ultimately, the error in the prosecution of the '211 Application came down to Applicant's prior attorney making amendments rather than submitting a Section 1.132 Declaration from Applicant. In an effort to attempt to rectify Applicant's previous attorney's error, Applicant submitted a Section 1.132 Declaration attached to the 9-10-01 Response to the 6-11-01 Office Action that states in paragraphs 5-6:

"5. The invention disclosed in the '685 patent was also disclosed, but not claimed in the co-pending '074 patent.

6. The application for the invention disclosed in the '074 patent was co-pending with the application for the '685 patent, and was derived by common inventors."

Paragraphs 5-6 satisfy the requirements of the Examiner's instructions during the prosecution of the '211 Application. Therefore, the error that was committed during the prosecution of the '211 Application was Applicant's prior attorney narrowing the scope of the claims by adding further limitations to subject matter that the Examiner had already stated was patentable. All that Applicant had to do was file a declaration saying that the disclosed but unclaimed subject matter in the copending '596 Application were in fact invented by the common inventor.

Applicant's prior attorney limiting the claims rather than filing a declaration, without even consulting Applicant as occurred in this case, cannot be characterized as outside of the realm of a clear error, mistake, or inadvertence within the protections of Section 251. Furthermore, Applicant filed the Reissue App. '277 within the two-year limit as prescribed under Section 251. Under the facts of this case, the number and type of errors occurring during the

prosecution of the original application caused the patent that is the subject of Reissue App. '277 to claim less than the inventor/Applicant was entitled, which caused the patent to be wholly or partly inoperative.

- (b) Under these facts, Applicant did not surrender the scope of the subject matter in the claims present in the reissue application because Applicant did not admit the claims were unpatentable, and an inference of unpatentability cannot be drawn when there was no express admission and the entire prosecution history is analyzed.**

In order to apply the Recapture Doctrine, a determination under the second step of the two-step test found in In re Clement of whether the scope was surrendered is necessary. In re Clement, 131 F.3d at 1468-69. The prosecution history of the patent that is the subject of the reissue application must be examined to determine whether the scope was surrendered, because "the recapture rule does not apply in the absence of evidence that the applicant's amendment was 'an admission that the scope of the that claim was not in fact patentable.'" In re Clement, 131 F.3d at 1469, *quoting* Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984). The Recapture Doctrine should not bar Applicant's reissue claims because amendments and cancellations of claims are not dispositive of an admission that a claim is unpatentable, and under the prosecution history of the original application Applicant never admitted that the scope of the claims that were amended was not patentable.

Hester, Mentor, and In re Clement, state that "reissue error is generally liberally construed, and we have recognized that an attorney's failure to appreciate the full scope of the invention is not an uncommon defect in claiming the invention." In re Wilder, 736 F.2d 1516, 1519, 222 U.S.P.Q. 369, 371 (Fed. Cir. 1984), *cited by* Mentor, 998 F.2d at 995, *cited by* In re Clement, 131 F.3d at 1468, *and cited by* Hester, 142 F.3d at 1479-80.

Furthermore, the Federal Circuit stated in Hester that prior opinions of the Federal Circuit indicate that, "as a general proposition, in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding the patentability." Hester, 142 F.3d at 1481. In coming to this conclusion the Federal Circuit noted its prior holdings in In re Clement and Mentor, where it stated that the Recapture Doctrine does not apply in the absence of reliable evidence that the amendment was an admission that the scope of the claim was not in fact patentable. Hester, 142 F.3d at 1481, *citing* In re Clement, 131 F.3d at 1468, *citing* Mentor, 998 F.2d at 995. Finally, in Ball, the Federal Circuit again emphasized that the deliberate cancellation of claims may constitute error under Section 251 if it occurs without deceptive intent, and in such circumstances error is established where there is no reliable evidence that the appellant intentionally omitted or abandoned the claimed subject matter. Ball, 729 F.2d at 1435.

The simple reason for such statements from these courts is that the Recapture Doctrine is based on fundamental principles of equity and fairness. Hester, 142 F.3d at 1481. As with any judicially created rule or doctrine, the facts of the case at hand determine what is fair. It is important to remember the comments of Mr. Justice Brown in Topliff:

"...The object of the patent law is to secure to the inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by too strict and technical adherence to the letter of the statute, or by application of artificial rules of interpretation."

145 U.S. 156, 171, 12 S.Ct. 825, 831 (1891) (as *quoted in* In re Willingham, 282 F.2d at 731)

In determining whether subject matter has been surrendered, we cannot simply follow the policy found in Section 1412.02 of the MPEP and find that an amendment was made in response to a rejection, therefore it was surrendered. Without an admission, the most a court can surmise from an amendment is an inference of unpatentability. With respect to drawing inferences

without an admission, however, the Federal Circuit has even cautioned that courts can only draw inferences from the amendments to claims "when other reliable evidence of the patentee's intent is not available." In re Clement, 131 F.3d at 1469, *citing* Ball, 729 F.2d at 1436. The USPTO is not using standards conforming with those developed by the Courts because the MPEP policies do not allow for Examiner determinations of equity. Rather the USPTO policies mandate applying strict rules without looking at the rest of the prosecution history of each case. The proper policy is to look to the prosecution history for evidence of an admission beyond the amendment itself, because as the court has stated in In re Clement:

"Deliberately canceling or amending a claim to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, *but it is not dispositive because other evidence in the prosecution history may indicate the contrary.*"

In re Clement, 131 F.3d at 1469 (emphasis added), *citing* Mentor, 998 F.2d at 995-96, *and citing* Ball, 729 F.2d at 1438 (the applicability of the recapture rule and the sufficiency of error under Section 251 turn in this case, *in the absence of other evidence of the patentee's intent*, on the similarity of the reissue and the cancelled claims).

The prosecution history of the '211 Application shows among other things, that Applicant's prior attorney tried to remedy the inventorship issue and failed, but neither the Applicant nor Applicant's prior attorney ever admitted, through their affirmations or actions, that the subject matter in those claims were unpatentable. Without a positive affirmation that the scope of the subject matter was not patentable, the prosecution history must be analyzed to see if an intent or admission can be inferred from the circumstances.

First of all, the Examiner admitted that the claims that were later amended were patentable subject matter. In the 3-3-97 Office Action, the Examiner stated in the section entitled "Allowable Subject Matter" that "claim 1 would be allowable if rewritten or amended to

overcome the rejection under 35 U.S.C. § 112," and "claims 2-14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all the limitations of the base claim and any intervening claims." (See Paragraphs 11-12 of the 3-3-97 Office Action). Although it is true that the Examiner provisionally rejected Claims 1-3, 6, and 9-14 as being obvious under Section 102(e)/103 in paragraph 10, in paragraph 10, the Examiner went on to suggest a manner of obviating the rejection without amending the claims with further limitations:

"This provisional rejection might be overcome either by a showing under 37 C.F.R. 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention 'by another' ..."

As is evidenced by the combination of the suggestion from the Examiner of how to obviate the Section 102(e)/103 provisional rejection, and the section on "Allowable Subject Matter" only discussing the Section 112 rejections, even the Examiner thought that the scope of the subject matter in the original claims was patentable during the 3-3-97 Office Action. At this point in the prosecution history, Applicant's prior attorney and the Examiner appeared to believe that the scope of the subject matter of all of the claims was patentable.

Moving through the prosecution history of the '211 Application, the May 14-15, 1997 Interviews also do not show that either Applicant or Applicant's prior attorney believed the provisionally rejected Claims 1-3, 6, and 9-14 were unpatentable. In fact, according to the Examiner's Interview Summary, Applicant's prior attorney brought up that Applicant was a common inventor and the common owner of the '211 Application and the copending '596 Application that was cited as prior art in both of the obviousness-type double patenting provisional rejections. Applicant's prior attorney's statement does not suggest that Applicant's prior attorney was admitting unpatentability. From the interview summary, Applicant's prior attorney did not make any representation that any of the claims were not patentable. The

Examiner Interview Summary also indicates that the Examiner informed Applicant's prior attorney that "filing a terminal disclaimer would obviate the remaining double patenting rejection." This statement from the Examiner to Applicant's prior attorney again makes it appear that the Examiner believed that the scope of the subject matter of the claims was patentable. Although the Interview Summary also states that the Examiner told Applicant's prior attorney an alternative as to how to obviate the double patenting provisional rejections, the actions of Applicant's prior attorney in the 6-9-97 Response to the 3-3-97 Office Action show that Applicant's prior attorney still believed the scope of the subject matter of the claims was patentable.

Applicant's prior attorney first amended the claims to obviate the Section 112 rejections. Second, following the Examiner's advice from the May 14-15, 1997 Interviews, the attorney also filed a Terminal Disclaimer to obviate the obviousness-type double patenting rejections. This Terminal Disclaimer also showed evidence of common ownership. Third, in the portion of Applicant's response discussing the Section 102(e)/103 provisional rejections on page 11, the prior attorney expressed gratitude to the Examiner for advice on resolving the rejection, and stated that the verification by the Examiner that the parent and the copending applications were assigned to the same person obviated this rejection. The attorney was incorrect in the effect that the Terminal Disclaimer would have on the rejection, but the attorney did perform all that he was told was required to obviate the remaining double patenting rejections from the Examiner's comments during the 9-30-97 Interview. The attempt and statement that the claims were now in full condition for allowance on page 12 of the 6-9-97 Response continues to evidence that Applicant's attorney believed the claims were patentable.

The first indication that Claims 1-3, 6, and 9-14 were not of patentable subject matter came in the 8-28-97 Final Office Action, when the Examiner stated for the first time that only Claims 4, 5, 7, and 8 were allowable if written in independent form including all of the limitations of the base claim and any intervening claims in the section entitled "Allowable Subject Matter." The Examiner did not cite any new reasons for rejecting Claims 1-3, 6, and 9-14. Until the 8-28-97 Final Office Action, there is not a single piece of evidence that either the Examiner, Applicant, or Applicant's prior attorney did not believe the subject matter in Claims 1-3, 6, and 9-14 to be patentable. The Examiner offers that the 9-30-97 Interview is evidence of an admission that the added limitations in amendments in response to the 8-28-97 Final Office Action were not patentable over the Section 102(e)/103 provisional rejection. In light of the circumstance surrounding the May 14-15 1997 Interviews, Appellant disagrees.

In light of the fact that the Examiner responded with the 8-28-97 Final Office Action after Applicant's attorney complied with the instructions from the May 14-15, 1997 Interview that "filing a terminal disclaimer would obviate the remaining double patenting rejection," the contents of the 9-30-97 telephonic interview do not show an admission by the attorney that the scope of the subject matter in the provisionally rejected claims was unpatentable. Rather, it shows Applicant's prior attorney was trying to find out if amending Claim 1 to include the limitation of Claims 2, 3, and 4, as opposed to the instructions in paragraph 5 of the 8-28-97 Office Action, would be acceptable to the Examiner.

In most circumstances, such an action might seem trivial. Recall, however, that Applicant's attorney had already been rejected after performing the tasks outlined by the Examiner in the May 14-15, 1997 Interviews. Amendments that do not place applications in condition for allowance or narrow the issues for appeal, do not have to be and are often not

entered by the Examiner under Sections 714.12 and 714.13 of the MPEP. Wanting to know if amending the claims in a way different from that outlined in the 8-28-97 Final Office Action is not an admission of unpatentability, but rather an attorney verifying that the amendments he is about to make will be accepted by the Examiner.

Under Ball, In re Clement, and Mentor, inferences of an admission from the amendment of claims in response to an office action are only proper "in the absence of other reliable evidence of the patentee's intent." Ball, 729 F.2d at 1436; In re Clement, 131 F.3d at 1469; Mentor, 998 F.2d at 995. From the prosecution history of the '211 Application, there is no statement or activity that appears to be an admission. Clearly, this should be accepted as reliable evidence of patentee's intent not to make any admissions against patentability, but his belief that the original claims were patentable over the cited art. The attorney tried to comply with the Examiner's instructions from the May 14-15, 1997 Interviews, and received the 8-28-97 Final Office Action.

The 9-30-97 Interview comments should not be looked at in a vacuum, but rather in context with the rest of the prosecution history. When the entire prosecution history and the events leading up to the 9-30-97 Interview Interview Summary Comments are considered, an inference would be improper. Because there is not an admission, and an inference of an admission would be improper considering the entire prosecution history, the Board should find that the subject matter was not surrendered. Therefore, making the application of the Recapture Doctrine is impermissible under these facts.

- (c) **Mistakes that cause the patent to be less protected than what the inventor deserved are what the equity-based decisions of the Supreme Court in the 1800's and the Reissue Statute were designed to remedy.**

The actions of Applicant's prior attorney were mistakes and nothing more. Mistakes that caused the patent to provide less protection than what the inventor deserved are what the equity-based decisions of the Supreme Court in the 1800's and the Reissue Statute were designed to remedy. When the Supreme Court struggled with balancing the rights of the public against the rights of the inventor, the Court decided that equity demands that a patentee "cannot after the issue of the patent broaden his claim by dropping the element which he was *compelled* to include in order to secure his patent." Shepard, 116 U.S. at 597 (emphasis added). There is nothing in the prosecution history of the '211 Application that indicates that Applicant was *compelled* to make the amendments beyond that which the Examiner indicated was patentable. At every phase of the original prosecution, the Examiner offered the Section 1.132 Declaration as a solution to the provisional Section 102(e)/103 rejection.

The Federal Circuit cases that involve broader language were brought about because the Federal Circuit recognized that arguments to obviate prior art rejections (without changes to the claims) should also limit the patentee's rights to broaden his claims. Hester, 142 F.3d at 1481; In re Clement, 131 F.3d at 1470-71; Mentor, 998 F.2d at 995-96; Ball, 729 F.2d at 1436. Neither Applicant nor Applicant's prior attorney made any arguments around the prior art cited against the '211 Application. Therefore, equitable principles should determine whether to allow Applicant to correct his attorney's mistake and get protection for that which was actually his invention. The amendments to the '211 Application were not compelled, therefore, Applicant should be allowed to claim the full scope of his invention that was available upon providing the 37 C.F.R. § 1.132 Declaration.

The courts have continuously stated that in considering the error requirement of Section 251, the courts must keep in mind that the Recapture Doctrine is based on fundamental principles of equity and fairness, and should be construed liberally in order to secure to the inventors protection for what they have actually invented. Hester, 142 F.3d at 1479, In re Richman, at 1088 n. 3, In re Willingham, 282 F.2d at 354-56; Grant, 6 Pet. at 240-41 (opinion by Chief Justice Marshall); Topliff, 145 U.S. at 831 (opinion by Justice Brown). The Examiner indicated in the first Office Action that all of the claims were of allowable subject matter. Applicant's prior attorney tried, though unsuccessfully, to file the documents in his response that would obviate the Section 102(e)/103 rejection according to the instructions from the Examiner. Applicant's prior attorney did not communicate the options available to Applicant after the 8-28-97 Final Office Action, before making the amendments in response to the Section 102(e)/103 provisional rejections.

In light of these circumstances in the prosecution history, it would be contrary to fundamental principles of equity and fairness to infer that the Applicant's prior attorney's amendment and the request for verification that the proposed amendments would obviate the Section 102(e)/103 provisional rejection amount to an admission that the scope of the subject matter in Claims 1-3, 6, and 9-14 were unpatentable. The Recapture Doctrine cannot be applied unless an inference that such an admission was made. Therefore, equity and fairness demand that the Recapture Doctrine should not be applied in this case to insure that the inventor can secure protection for that which he actually invented.

XI. CONCLUSION

A reissue application is a warranty that a patentee can use to correct the prosecution errors by broadening or narrowing the scope of the patent as long as it is applied for within a specified time period. As with an inventor's right to a reissue application, as well as most

judicially created doctrines, the Recapture Doctrine is also based on fundamental principles of equity and fairness. Securing to the inventors a temporary monopoly to that which they actually invented is the object of the patent laws. Topliff, 145 U.S. at 171. Mr. Justice Marshall warned that this object ought not be defeated by too strict and too technical an adherence to the letter of the statute, or by artificial rules of interpretation. Topliff, 145 U.S. at 171. For this reason, the courts have continuously stated that in considering the error requirement of Section 251, the courts must keep in mind that the Recapture Doctrine is based on fundamental principles of equity and fairness, and should be construed liberally in order to secure to the inventors protection for what they have actually invented. Grant, 6 Pet. at 240-41 (opinion by Chief Justice Marshall); Topliff, 145 U.S. at 831 (opinion by Justice Brown); Hester, 142 F.3d at 1479, In re Richman, at 1088 n. 3, In re Willingham, 282 F.2d at 354-56.

The USPTO, however, is doing precisely that which the Supreme Court cautioned against by promulgating rules that are not representative of the equitable principles behind the Recapture Doctrine, especially in view of the rules following the strictest pronouncements of the Federal Circuit without recognizing the more liberal application of the law found within the very same cases. The policies promulgated by the USPTO, as they are applied to the facts in this case, are inconsistent with Congress and the Courts by not allowing inventors, who are seeking reissue after a change in the law, to benefit from the added protections afforded by Congress.

Under the facts of this case, it is against fundamental principles of fairness and equity to prevent inventors from benefiting from a change in the law between the original application and the reissue application when the Courts have announced that the reissue application should be prosecuted under the law at the time of reissue, and when the reissue application was filed within the two-year statutory bar. Furthermore, under the facts of this case, it is against the fundamental

principles of fairness and equity to allow the USPTO to use the Recapture Doctrine to prevent inventors from remedying the mistakes in the prosecution when the reissue statute is a tool or warranty for repairing errors and mistakes in the prosecution of an application that causes and inventor not to have protection for that which he actually invented.

XII. APPENDICES

Appendix A provides a copy of the claims presented in this appeal.

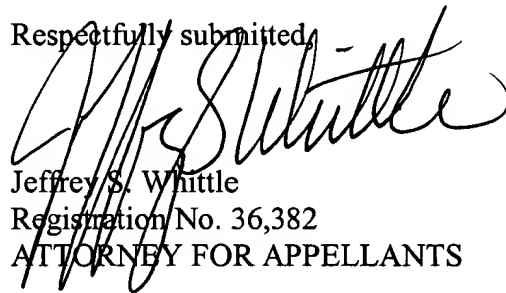
Appendix B provides a copy of the Terminal Disclaimer to Obviate the Double Patenting Rejections of the '211 Application.

XIII. PRAYER FOR RELIEF

For the foregoing reasons, it is submitted that the Examiner's rejections of Claims 12 through 22 are erroneous, and reversal of this decision is respectfully requested.

Date: 7/26/02
BRACEWELL & PATTERSON, L.L.P.
711 Louisiana Street, Suite 2900
Houston, TX 77002-2781
Telephone: (713) 221-1185
Facsimile: (713) 221-2141

Respectfully submitted,



Jeffrey S. Whittle
Registration No. 36,382
ATTORNEY FOR APPELLANTS

12. (Amended) A temporary guardrail system for removable attachment to a building under construction, the system comprising:

a plurality of upright stanchions;

an anchor bracket connected to a bottom end of each respective one of the plurality of stanchions;

a plurality of vertically spaced-apart side rails connected to each of the plurality of stanchions;

means for rotatably connecting said side rails to said stanchions enabling each respective side rail to be rotated about a longitudinal axis of each respective stanchion on a horizontal plane and each respective side rail to be pivoted at varying angles in a vertical plane, said connecting means including a first threaded stud outwardly projecting from a top end of said stanchions in substantially axial alignment therewith enabling each of said side rails to be rotatably mounted thereon at various angles, said side rails being pivoted in a vertical plane at varying angles;

means for telescopically adjusting the length of each respective side rail enabling said temporary guardrail system to be adapted to dimensional features of different buildings under construction; and

means for selectively extending the vertical height of said guardrail system for employees performing specialized tasks requiring ladders and stilts adjacent thereto.

13. (Amended) The temporary guardrail system of Claim 12, further comprising swiveling means having a pair of studs arranged in parallel and spaced-apart relation, said studs being disposed in perpendicular relation to said axis of said stanchion enabling a pair of adjacent side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines.

14. (Amended) The temporary guardrail system of Claim 12, wherein said connecting means for said side rails comprises at least one rail support collar attached to each of said side rails, said at least one rail support collar being disposed about said stanchion and having at least one threaded stud outwardly extending therefrom and being perpendicular to a center axis of said collar enabling said angulation means of said side rails to be fixedly mounted on said at least one threaded stud.

15. (Amended) The temporary guardrail system of Claim 14, further comprising angulation means positioned to cooperate with said side rails, wherein said angulation means comprises a mid-rail, swivel bracket disposed on said at least one threaded stud extending from said rail support collar, said mid-rail, swivel bracket including an elongated body member and further including swiveling means being adapted for pivoting movement in a plane parallel to the plan defining said elongated body member, said swiveling means of said mid-rail, swivel bracket including a threaded stud mounted in perpendicular relation to said axis of said stanchion enabling said side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines.

16. (Amended) The temporary guardrail system of Claim 15, wherein said swiveling means of said mid-rail, swivel bracket includes a pair of threaded studs arranged in generally parallel, spaced-apart relation enabling a pair of said side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines such as flights of stairs.

17. (Amended) The temporary guardrail system of Claim 14, wherein a plurality of rail support collars are disposed about said stanchions at a pre-determined vertical location in an operative relationship between at least two rail stops.

18. (Amended) The temporary guardrail system of Claim 12, wherein said extending means includes a plurality of extension posts being adapted for sliding engagement about the outside diameter of said stanchions at upper ends thereof, said extension posts including connecting means so as to permit attachment of a plurality of vertically spaced side rails thereon enabling the vertical height of said temporary guard rail system to be selectively extended.

19. (Amended) The temporary guard rail system of Claim 12, wherein each respective stanchion is fixedly attached to a ground anchoring means for installation directly onto a ground surface.

20. (Amended) The temporary guard rail system of Claim 19, wherein said ground anchoring means is fabricated from a heavy gauge, corrugated sheet metal material that is adapted to receive a plurality of anchor pins therethrough for securing said ground anchoring means directly to the surface of the ground.

21. (Amended) The temporary guard rail system of Claim 12, wherein each respective stanchion is adapted for installation on a roof anchoring means fabricated from corrugated sheet metal.

22. (Amended) The temporary guard rail system of Claim 21, wherein said roof anchoring means is matched to the configuration of said corrugated sheet metal.



**TERMINAL DISCLAIMER TO OBTAIN A PROVISIONAL DOUBLE
PATENTING REJECTION OVER A PENDING SECOND APPLICATION**

Docket No.

P-3266a

In re Application of: **Harrison G. Purvis and Lonnie E. Arnold, Jr.**
Application No. **08/620,211**
Filed: **3/29/96**
For: **TEMPORARY GUARDRAIL SYSTEM**

RECEIVED

JUN 24 1997

8/19/97

The owner, **Harrison G. Purvis** of **2500** percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number **08/755,596**, filed on **11/25/96**

The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

3. Owner/applicant is ☒ Small entity ☐ Large entity

The terminal disclaimer fee under 37 CFR 1.20(d) is **\$55.00** and is to be paid as follows:

- ☒ A check in the amount of the fee is enclosed.

- ☐ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number _____ A duplicate copy of this sheet is enclosed.

PTO suggested wording for terminal disclaimer was

- ☒ unchanged. ☐ changed (if changed, an explanation should be supplied.)

Clifford F. Rey
Signature

Dated:

May 15, 1997

Name and Address of Person Signing

Clifford F. Rey, Reg. No. 37,920
MILLS AND ASSOCIATES
P.O. BOX 587
Wake Forest, NC 27588

I certify that this document and fee is being deposited on _____ with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Clifford F. Rey
Signature of Person Mailing Correspondence

Clifford F. Rey

Typed or Printed Name of Person Mailing Correspondence